IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF PENNSYLVANIA

In Re Subpoena Served on Michael Ian Shamos	)	Case No. 2:10-MC-00002-DSC **ELECTRONICALLY FILED**

MEMORANDUM OF POINTS AND AUTHORITIES

I. INTRODUCTION

Accenture and Dr. Shamos recognize that the Court narrowed the scope of Guidewire's subpoena, but the tremendous burden and expense to comply with the December 9, 2010 Order ("Order") still ***far*** outweighs any potential benefit of this discovery to Guidewire.

First, the Order presents Dr. Shamos with a Hobson's Choice—either comply with the Order and violate many other court orders in cases in which Dr. Shamos has served as an expert, which require him to keep confidential details of those cases; or fail to comply with the Order and face contempt of this Court.

Second, the scope of the subpoena, even as modified, would force Dr. Shamos to spend over 450 hours gathering documents, which in turn would cost Accenture on the order of a quarter million dollars. The burden and lack of relevance is compounded by the fact that the subpoena calls for discovery that Guidewire clearly does not need because Guidewire was ***ready to go to trial nine months ago without it***.[1]

To prevent manifest injustice on Dr. Shamos and Accenture, Accenture respectfully requests reconsideration of the Court's Order of December 9, 2010.

II. FACTUAL AND PROCEDURAL HISTORY

Since 2007, Accenture and Guidewire have been engaged in a patent and trade secret case in the U.S. District Court for the District of Delaware (C.A. No. 07-826-SLR). Dr. Shamos serves as an expert witness on behalf of Accenture, and has submitted several expert reports and testified in deposition. On December 23, 2009, Guidewire served a subpoena on Dr. Shamos. (Docket No. 2-4.) Accenture and Dr. Shamos promptly moved to quash this subpoena on January 6, 2010 on the grounds that the documents requested were overbroad with respect to their temporal and substantive scope, and called for documents from unrelated litigations involving unrelated parties. (Docket No. 1.) An opposition brief, reply brief, and sur-reply brief were filed on January 11, January 15, and January 15, respectively. (Docket Nos. 3, 5, and 7.)

On December 9, 2010, this Court ordered Accenture and Dr. Shamos to comply with the following requests for production:

> 2. All expert reports in which you have participated. Pursuant to the stipulated protective order, this request expressly excludes draft reports prepared in connection with the proceeding currently pending in Federal Court for the District of Delaware entitled *Accenture Global Services GmbH, et al v. Guidewire Software, Inc.*, CA No 07-826-SLR.

[1] The *Accenture v. Guidewire* case was set for trial on March 15, 2010, but was stayed on February 28, 2010 pending the Supreme Court's opinion in *Bilski v. Kappos*, 561 U.S. -- (2010). The Honorable Sue Robinson has not yet set a new trial date. Guidewire has never argued that it was not ready to go to trial because of this pending subpoena to Dr. Shamos.

4. Any document on which you intend to rely to support a claim of knowledge of, familiarity with, or expertise in insurance.

5. All documents relating to any work you have done with claims-handling software, including but not limited to all course work, self-study, and professional experience with claims-handling software, and any other document on which you intend to rely to support a claim of knowledge of, familiarity with or expertise in claims-handling software.

7. All notes, text, slides or handouts for any prepared remarks or speeches you have given relating to the topics of insurance, claims-handling software, intellectual property, electronic commerce, software, or object oriented programming.

9. All press articles in which you have been quoted, cited, or referred to as an expert or authority.

10. All correspondence between you and the United States Patent and Trademark Office on any topic about which you intend to testify in the above-captioned litigation, including but not limited to correspondence that you received (even if not directly addressed to you) and correspondence to which you contributed (even if not expressly signed by you).

(Docket No. 9.)

The Court also ordered Accenture and Dr. Shamos to comply with the following requests for production subject to certain Court modifications (with additions in brackets and underlined and deletions in brackets and strikethrough):

1. All prior testimony you have given, in deposition, at trial, in arbitration or in any other similar proceeding [to the extent it relates to the fields of insurance, claims-handling software, and intellectual property matters, with plaintiffs bearing all costs. As to prior testimony relating to all other fields, plaintiffs shall indentify all prior testimony and then assist in and take whatever steps necessary to provide defendant with the ability to obtain such testimony, with costs of production to be borne by defendant].

3. All documents relating to your knowledge of insurance [claims-handling,] [insurance claims-handling software, and/or computer software systems used in the insurance industry], including but not limited to all course work, self-study, and/or professional experience in insurance.

> 6. All publications you have authored or contributed to in the fields of insurance, [insurance claims-handling,] [insurance] claims-handling software, intellectual property, electronic commerce, software, object oriented programming or expert testimony [to the extent they are available online or in formal publications that requires no cost to acquire. The production of all publications will be required at plaintiffs' cost to the extent that there are fees or charges associated with access and/or acquisition of the publication].
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> 8. All materials (whether or not authored by you) from any class or course for which you have been an instructor [in the last 10 years] relating to the fields of insurance, [insurance claims-handling,] [insurance] claims-handling software, [and] intellectual property [to the extent it relates to] electronic commerce, software, or object oriented programming including but not limited to copies of all textbooks used in those courses, syllabi or lists of required reading for students in those classes [~~, tests, quizzes, exams, answer keys, essay topics and sample answers~~].
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> 11. All patent applications you have filed or submitted and the related file histories [to the extent they relate to (1) the fields of insurance, (2) insurance claims-handling systems or software, and (3) intellectual property matters insofar as they relate to electronic commerce, software, or object-oriented programming].

(*Id.*)

While the Court's modifications narrow the scope of some of the document requests, the modified subpoena continues to pose at least two significant problems:

First, Dr. Shamos has served as an expert witness in approximately 100 other matters, and most of them involve protective orders that limit his ability to (or flatly prohibit him from) disclosing his expert reports and testimony containing confidential information. Declaration of Michael Shamos in Support of Accenture's Motion for Reconsideration ¶ 4 ("Shamos Decl."). Requests 1 and 2 still require Dr. Shamos to produce documents that are subject to protective orders in his other cases. Under many of these other court orders, Dr. Shamos must give notice to ***each party*** whose confidential information is subject to disclosure, and obtain that party's permission prior to making a disclosure. It would take months to contact all counsel and parties who may have an interest in maintaining confidentiality of their information. Shamos Decl. ¶¶ 5,

7. Such an effort would require at least ***275 hours*** of work by Dr. Shamos. *Id*. And there is no guarantee that Dr. Shamos would be authorized to disclose the requested material even ***after*** contacting counsel and the parties. *Id*.

Second, Requests 6, 7, 8, 10 and 11, even as modified, require Accenture and Dr. Shamos to expend an undue amount of time and expense that substantially outweighs any possible benefit to Guidewire. To comply with these five requests would require, at a minimum, ***an additional 195 hours*** of attorney and expert time. *Id.* ¶¶ 9-22. According to Dr. Shamos, the total amount of time required to comply with the subpoena proposed by the Court is at least 470 hours. *Id.* ¶ 23. This would cost Accenture at least $258,000. *Id.* Due to Dr. Shamos' busy schedule, which involves teaching and other expert witness engagements, it would take many months to complete these 470 hours of work. *Id.*

However, with minor modifications that focus Guidewire's subpoena on potentially relevant material within Dr. Shamos' possession, custody, and control, the burden of compliance can be reduced to just over 110 hours of work for Dr. Shamos. *Id.* ¶ 24. Even with Dr. Shamos' busy schedule, he should be able to complete this more limited document collection by April 2011. *Id.*

III. ARGUMENT

The Court should reconsider its December 9 Order and further modify Guidewire's subpoena so that Dr. Shamos can comply without having to violate other court orders, and without being unduly burdened. The extent of the burden on Dr. Shamos—the potential violation of protective orders in other litigations and the exorbitant amount of time required to comply with the subpoena—may not have been clear when the Court originally ruled on

Accenture's Motion to Quash. A motion to reconsider is warranted here because the Court can easily prevent any manifest injustice by further narrowing the scope of the subpoena.

A. A Motion for Reconsideration Is Appropriate Here to Prevent Manifest Injustice.

A motion to reconsider is warranted to prevent manifest injustice. *North River Ins. Co. v. CIGNA Reins. Co.*, 52 F.3d 1194, 1218 (3d Cir. 1995); *Waye v. First Citizen's Nat'l Bank,* 846 F. Supp. 310, 313-14 (M.D. Pa. 1994), *aff'd*, 31 F.3d 1175 (3d Cir. 1994); *Reich v. Compton*, 834 F. Supp. 753, 755 (E.D. Pa. 1993). Here, the Court should reconsider its December 9 Order in order to prevent manifest injustice on both Accenture and Dr. Shamos.

In the context of discovery orders, manifest injustice is a decision that would result in substantial prejudice to the aggrieved party. *Ameristar Jet Charter, Inc. v. Signal Composites, Inc.,* 244 F.3d 189, 192 (1st Cir. 2001). Prejudice can take the form of undue expense. *See, e.g., Oy Tilgmann, AB v. Sport Pub. Int'l., Inc.* 110 F.R.D. 68, 70 (E.D. Pa. 1986) (prejudice by necessitating additional discovery and expense).

Because the burden factor set forth in *Miller v. Allstate Fire & Cas. Ins. Co.*, No. 07-260, 2009 U.S. Dist. LEXIS 21225, at *4-5 (W.D. Pa. Mar. 17, 2009) was not clearly considered by the Court, Accenture respectfully requests that the Court reconsider its December 9 Order. In light of the *Miller* factors, the burden Guidewire's subpoena places on Dr. Shamos and Accenture justifies this Court in further narrowing Guidewire's subpoena. *See id.* (factors on undue burden or expense include relevance, a party's need for the production, scope, the time period covered by request, the request's particularity, and the burden imposed).

B. Accenture and Dr. Shamos Cannot Comply with Requests 1 and 2 Without Violating the Orders of Other Courts.

Requests 1 and 2 call for information subject to protective orders in other litigation. (Docket No. 1 at 8.)[2] Dr. Shamos cannot simply produce the documents as ordered by this Court. Courts have recognized that they are without authority to alter a protective order entered by another court by ordering production of documents within the scope of that protective order. *See, e.g.*, *Inventio AG v. ThyssenKrupp Elevator Americas Corp.*, 662 F. Supp. 2d 375, 384 (D. Del. 2009); *Four Pillars Enters. Co. v. Avery Dennison Corp.*, 308 F.3d 1075, 1080 (9th Cir. 2002) (affirming a district court denial of discovery that "would frustrate the protective order of [another] federal [district] court").

An order by this Court that would disrupt the protective orders in place in Dr. Shamos' other matters in which he has served as an expert, by compelling the production of documents from those matters, would place Dr. Shamos in an untenable position. If Dr. Shamos were to comply with this Court's order, he would face potential contempt or sanctions in other jurisdictions. *Quinter v. Volkswagen of Am.*, 676 F.2d 969, 974 (3d Cir. 1982) (expert witness violated protective discovery order when he turned over discovery material to unrelated counsel in another case).

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[2] In arguing that "Dr. Shamos may not be authorized or able to disclose the information requested" in Accenture's Motion to Quash Guidewire's Subpoena (Docket No. 1, at 8), while Accenture also referenced "privilege" as a basis for withholding such documents, the context makes it clear that Dr. Shamos is unable to produce expert reports and testimony to the extent they are subject to other courts' protective orders. *Id.* at 8, and n. 3. However, in its Order, the Court focuses on the lack of support of Dr. Shamos' claim of privilege, stating that Rule 45(d)(2) "imposes a duty…to make the claim of privilege expressly, and to support that claim with "a description of the nature of the documents, communications, or things not produced." Order at 7. But the requirement in Rule 45(d)(2) goes to documents withheld based on attorney-client privilege or attorney work product, so the requesting party can assess the basis for the privilege/work product assertions. *See* Rule 45(d)(2) (describe the nature of documents withheld that are "***privileged or subject to protection as trial-preparation material***") (emphasis added); *see also* Fed. R. Civ. P 26(b)(5)(describe the nature of documents withheld that are "***privileged or subject to protection as trial-preparation material***") (emphasis added). Rule 45(d)(2) is not intended to log documents protected by other courts' protective orders. Moreover, even if Accenture and Dr. Shamos were to prepare a log for such documents, Guidewire or this Court would be in no better position to assess the validity of the basis for withholding such documents.

Moreover, many of the protective orders in Dr. Shamos' other matters require that he give notice to and obtain permission from the parties in each of these other cases, should any confidential information be disclosed. Shamos Decl. ¶¶ 4, 5, 7. As a logistical matter, determining if Dr. Shamos has a copy of the relevant materials, and then providing notice and obtaining permission, is extremely burdensome, because Dr. Shamos has been involved in roughly 100 other litigation matters since 1984.[3] *Id.* ¶ 4. Dr. Shamos estimates that it would take at least 275 hours to contact, explain, and request permission from all of these former case parties. *Id.* ¶¶ 5, 7. Even then, there is no guarantee that the parties in these other litigation matters would permit Dr. Shamos to disclose any of their confidential information. *Id.*

Requiring Dr. Shamos to comply with Requests 1 and 2, even as modified, is unreasonable, as the Court would be forcing Dr. Shamos to choose between being in contempt of this Court, or of other courts in cases in which he has served as an expert.

C. Accenture and Dr. Shamos Cannot Comply with Requests 6, 7, 8, 10 and 11 without Incurring Unduly Burdensome Expense.

While Accenture and Dr. Shamos appreciate the Court's narrowing of select requests for production, Requests 6, 7, 8, 10 and 11 are still unduly burdensome, and compliance would force Dr. Shamos and Accenture to expend undue time, effort, and resources.

[3] Request 1, even as modified, still encompasses "intellectual property," and therefore it includes essentially every case in which Dr. Shamos has served as an expert. Shamos Decl. ¶¶ 2, 3. In contrast, Rule 26 only requires an expert to disclose his prior testimony in the preceding ***four*** years. Fed. R. Civ. P 26(a)(2)(B)(v).

Specifically, Request 6 requests all publications that Dr. Shamos has contributed to, regardless of when, that relate to "insurance, claims-handling software, intellectual property, electronic commerce, software, and object oriented programming."[4] Similarly, Request 7 requests all notes, text, slides or handouts for any prepared remarks or speeches Dr. Shamos has given relating to "insurance, claims-handling software, intellectual property, electronic commerce, software, and object oriented programming." Because nearly all of Dr. Shamos' teaching, work and expertise touch upon "intellectual property" or "software," the scope of these requests essentially is the same as before the Court's modification.[5]

Moreover, both of these requests are extremely burdensome, since Dr. Shamos has been lecturing and writing on these topics for almost forty years.[6] Shamos Decl. ¶ 11. For example, he has given over 2,000 presentations on the potentially relevant topics. *Id.* In order to comply with these two requests, Dr. Shamos would have to locate his articles and publications, reconstruct his lecture list from the past forty years, search for documents in connection with these lectures, and then review each for responsiveness. This amounts to roughly 150 hours of work. Shamos Decl. ¶¶ 9, 12.

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[4] This Court ordered that Request 6 be narrowed to include only documents that "are available online or in formal publications that requires no cost to acquire." Order at 6. However, the Court then ordered "production of all publications will be required at ***plaintiffs'*** cost to the extent that there are fees or charges associated with access and/or acquisition of the publication." *Id.* (emphasis added). Accenture also requests clarification of this language, as reading the paragraph as a whole, it appears that the Court intended to shift some of the cost to the defendant, as opposed to requiring plaintiffs to also pay for publications that are only available for a fee. *Compare with* modified Request 1 ("As to prior testimony relating to all other fields, plaintiffs shall identify all prior testimony…with costs of production to be borne by ***defendant***). *Id.* at 5 (emphasis added).

[5] Indeed, the term "intellectual property" encompasses not only patents and trade secret, but also copyright and trademark, which cannot possibly be relevant to the Accenture-Guidewire litigation, but in which Dr. Shamos has considerable expertise and experience.

[6] In contrast, Rule 26 only requires an expert to disclose his publications in the prior ***ten*** years. Fed. R. Civ. P 26(a)(2)(B)(iv).

Moreover, Request 8 also includes the broad category "intellectual property." And while it is limited to electronic commerce, software, or object oriented programming, "software" is what Dr. Shamos has been teaching since the 1970's. Compliance with the Order would require Dr. Shamos to search for and obtain numerous outdated textbooks, some of which may be packed away or out of print. This would require roughly another 20 hours, if it could be accomplished at all. Shamos Decl. ¶ 14.

Finally, Requests 10 and 11 are unduly burdensome and call for documents that simply have no relevance to the underlying litigation. Dr. Shamos has served as an attorney, inventor, and expert in connection with matters before the PTO. *Id.* ¶ 16. Request 10 would require Dr. Shamos to review all correspondence between him and the PTO, as well as any correspondence he may have received or contributed to (even if not directly addressed to or from him), to determine if it is related in any way to a topic about which he intends to testify in the Accenture litigation. *Id.* ¶ 16. Much of the correspondence is not in Dr. Shamos' possession, custody or control. *Id.* ¶¶ 16, 17. Similarly, Request 11 would require Dr. Shamos to review his work as a patent attorney to identify the patents he filed on behalf of clients, as well as patent applications on which he is a named inventor. *Id.* ¶¶ 16, 20. As a patent attorney, Dr. Shamos' correspondence and patent applications represent his clients' positions and not his own. *Id.* ¶ 16. Those positions are not relevant to Guidewire.[7]

[7] As to patents and applications on which Dr. Shamos is a named inventor, they are publicly available, and Guidewire can easily access them, at little or no cost. *Purdue Pharma Prods. L.P. v. Par Pharms., Inc.,* No. 07-255-JJF, 2008 U.S. Dist. LEXIS 65944, at *8 (D. Del. Aug. 28, 2006) (quashing defendant's deposition subpoena when much of the information sought is publicly available).

D. Accenture's Proposed Further Amended Subpoena Eliminates the Potential Violation of Other Court Orders and Reduces Undue Burden on Dr. Shamos and Accenture.

Accenture proposes the following amendments (additions in brackets and also underlined and deletions in brackets and strikethrough) to the requests for production proposed by the Court in its Order:[8]

> 1. All prior testimony you have given [within the last 10 years], in deposition, at trial, in arbitration or in any other similar proceeding to the extent it relates to the fields of insurance, claims-handling software, and [~~intellectual property matters~~] [patent or trade secret matters], with plaintiffs bearing all costs. [Plaintiffs shall identify all such prior testimony that is confidential and/or to be withheld from release pursuant to any protective order.] As to prior testimony relating to all other fields, [~~plaintiffs shall indentify all prior testimony and then assist in and take whatever steps necessary to provide defendant with the ability to obtain such testimony, with costs of production to be borne by defendant.~~] [plaintiffs shall identify all prior testimony.]
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> 2. All expert reports in which you have participated [within the last 10 years to the extent it relates to the fields of insurance, claims-handling software, and patent or trade secret matters]. [Plaintiffs shall identify all such expert reports that are confidential and/or to be withheld from release pursuant to any protective order.] Pursuant to the stipulated protective order, this request expressly excludes draft reports prepared in connection with the proceeding currently pending in Federal Court for the District of Delaware entitled *Accenture Global Services GmbH, et al v. Guidewire Software, Inc*., CA No 07-826-SLR.
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> 6. All publications you have authored or contributed to [within the last 10 years] in the fields of insurance, insurance claims-handling, insurance claims-handling software, [~~intellectual property~~] [patents, trade secrets], [~~electronic commerce, software,~~] object oriented programming or expert testimony to the extent they are available online or in formal publications that requires no cost to acquire. The production of all publications will be required at [~~plaintiffs'~~] [defendant's] cost to the extent that there are fees or charges associated with access and/or acquisition of the publication.
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> 7. All notes, text, slides or handouts for any prepared remarks or speeches you have given [within the last 10 years] relating to the topics of insurance, claims-

[8] A clean version of Accenture's proposed further amended subpoena is set forth in the Proposed Order Granting Accenture's Motion For Reconsideration, file herewith concurrently.

handling software, [~~intellectual property~~] [patents, trade secrets], [~~electronic commerce, software,~~] or object oriented programming.

8. All materials [~~(whether or not authored by you)~~] from any class or course for which you have been an instructor in the last 10 years relating to the fields of insurance, insurance claims-handling, insurance claims-handling software, and [~~intellectual property~~] [patents or trade secrets] to the extent it relates to [~~electronic commerce, software, or~~] object oriented programming, including but not limited to copies of all [~~textbooks used in those courses,~~] syllabi or lists of required readings for students in those classes.

10. All correspondence between you and the United States Patent and Trademark Office on any topic about which you intend to testify in the above-captioned litigation, including but not limited to correspondence that you received (even if not directly addressed to you) and correspondence to which you contributed (even if not expressly signed by you) [to the extent you possess copies of such correspondence and such correspondence does not relate to your legal representation of a client before the United States Patent and Trademark Office].

11. All patent applications you have filed or submitted [as an inventor] and the related file histories to the extent they relate to (1) the fields of insurance, (2) insurance claims-handling systems or software, and (3) intellectual property matters insofar as they relate to electronic commerce, software, or object-oriented programming.

Adopting these minor amendments would reduce the burden on Accenture and Dr. Shamos to a still substantial, but more reasonable, 114 hours of work. Shamos Decl. ¶¶ 6, 8, 10, 13, 15, 19, 21, 22, 24.

IV. CONCLUSION

Were Dr. Shamos to comply with this Court's December 9 Order, he would risk violating many other court orders, because the documents he has been ordered to produce contain confidential information from many third parties. Moreover, Dr. Shamos would also be forced to spend hundreds of hours to locate and review potential responsive documents, accumulated during the span of his forty-year career. Compliance would cost Accenture on the order of $250,000.

Accenture and Dr. Shamos respectfully request that the Court reconsider its December 9 Order and further modify the subpoena as proposed by Accenture.

Respectfully submitted,

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